

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

**REMARKS/ARGUMENTS**

Claims 1-6 and 9 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 11 and 13 of copending application no. 10/764,237. Responsive thereto, enclosed herewith is a duly executed Terminal Disclaimer which disclaims the term of any patent that may issue on the instant application that may extend beyond the term of any patent that may be granted on copending application no. 10/764,237. Accordingly, withdrawal of the outstanding double patenting rejection of claims 1-6 and 9 is respectfully requested.

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 870,330 to Wilde. Such rejection is respectfully traversed.

In regard to Wilde, Applicants initially note that the Wilde device is an ear ring. It is not a hair holding device. As explained below, it would be essentially useless in holding a lock or shock of hair.

Simple inspection of FIGS. 1 and 5 of the Wilde patent reveals that the opposed convex "dished ends" 7 and 11 of spring frame "a" and clamping member "b", which together apply clamping force to retain the ear ring on a user's ear, present very small cooperative clamping surface areas, i.e., areas sufficient to clamp a user's ear lobe. Even assuming such surfaces were as large as those shown in FIG. 5 of Wilde (which they very likely

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

would not be in practical use), and if they were attempted to be used to clamp a wearer's hair, they would clamp little more than a few strands of hair at the centralmost portions of the clamping surfaces. As a result, even if somehow adapted to a hair holding device, such a clamping arrangement would very likely quickly become disengaged from and fall from the user's hair.

Moreover, the hair holding device of Applicants' claim 1 specifically calls for hair gripping portions as being part of the first and second body members. The Examiner's statement of rejection in reliance upon Wilde is conspicuously silent regarding the presence of any hair gripping portions in the Wilde device. As such, the ear ring taught by Wilde does not anticipate the invention defined in Applicants' claim 1.

Applicants kindly submit that it would be legally improper hindsight to assert that it would have been obvious at the time of Applicants' invention to adapt the teachings of Wilde to hair holding device technology to produce a hair holding device having a non-slip friction adjustment means as prescribed in Applicants' claim 1. In this regard, the Examiner will note that the Wilde patent issued in 1907. In the 100 years since, as reflected not only the Wilde patent but also in the other references cited by the Examiner as being of interest, none have proposed the use of a non-slip friction adjustment means (or a slip friction adjustment means for that matter) outside of the ear ring art. In other words, inventors have had a century since issuance of the Wilde patent to conceive of a hair holding

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

device including a non-slip friction adjustment means. None have done so. This fact is compelling testament to the non-obviousness of Applicants' invention.

In the **Response to Arguments** section beginning at page 5 of the Final Office Action the Examiner indicated that Applicants' prior arguments with regard to Wilde (essentially replicated above) were not persuasive because "it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus satisfying the claimed structural limitations." *Ex parte Masham* 2 USPQ2d 1647 (1987).

Applicants reiterate that the Wilde device does not in fact satisfy the structural limitations of the presently claimed invention. Once again, the small convex clamping surfaces of spring frame "a" and clamping member "b" of Wilde simply could not possibly engage enough hair to retain the device on a shock of hair. They simply are not hair gripping portions of first and second members of a hair holding device.

Accordingly, withdrawal of the outstanding section 102(b) rejection of claim 1 and its dependent claims 3-6 based on Wilde is respectfully requested.

Claims 1, 3-6 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,546,750 to Sheehan. Such rejection is respectfully traversed.

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

The Sheehan device is a one-way gripping device (specifically, a cable tie) for permanently gripping strands, cables, wires and the like (see col. 1, lines 48-52). In fact, the curved arms 22 and 24 of the Sheehan device must be physically severed, thereby destroying the device, in order to remove it from the cables or like members about which it is bound (see col. 3, lines 15-19). The arms 22 and 24 of Sheehan are connected to a one-way ratchet mechanism that prevents reverse rotation of the arms (see col. 1, lines 24-27; col. 3, lines 3-14, lines 20-26 and lines 42-51; and col. 4, lines 1-4). Such a one-way gripping mechanism is the antithesis of the non-slip friction mechanism particularly recited in Applicants' claim 1 and described in Applicants' specification which purposely does permit reverse rotation of the hair gripping members. Consequently, Sheehan does not anticipate the invention defined in Applicants' claim 1.

In the ***Response to Arguments*** section of the Final Office Action the Examiner indicated that Applicants' prior arguments with regard to Sheehan (essentially replicated above) were not persuasive because "it is noted that the device not being a one-way gripping member is not recited in the claims or in the specification ...." In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With due respect, neither Applicants nor the undersigned can appreciate the Examiner's suggestion in this regard. It appears the Examiner is intimating that since Applicants' claims, which are already plainly structurally distinguishable

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

from the Sheehan device, do not expressly state that they are not a "Sheehan-type device", then Sheehan anticipates their structure. More specifically, it seems the Examiner is indicating that the claims of the present application must expressly state that the instant hair holding device is not a one-way gripping device such as in Sheehan, a device which must be destroyed after each use -- an unthinkable impracticality for a reusable hair holding device -- for Applicants' claims to be considered to be distinguishable from the Sheehan device. People simply do not wear cable ties or other permanently fixed devices on their hair. With due respect, any fair and reasonable reading of Applicants' specification and the Sheehan patent clearly belies this fallacy.

Accordingly, withdrawal of the outstanding section 102(b) rejection of claim 1 and its dependent claims 2-6 and 9 in reliance upon Sheehan is respectfully requested.

In addition, Applicants respectfully offer the evidentiary declarations of Ms. Rommy Revson and Ms. Mary Lafauci under 37 CFR § 1.132 in support of the patentability of Applicants' claimed invention. The proposed declarations of Ms. Revson and Ms. Lafauci are necessary at this time and were not earlier presented because it was believed, for reasons noted in Applicants' last response filed August 8, 2007, that once-amended claim 1 submitted with that response, in and of itself, patentably defined Applicants' invention over the cited prior art references of U.S. Patent No. 870,330 to Wilde ("Wilde") and U.S. Patent No. 3,546,750 to Sheehan. At that time, Applicants

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

did not believe it was necessary to supplement the compelling arguments submitted with that response (and reiterated above) with additional evidence of secondary considerations such as satisfaction of long-felt need. However, in a bona fide and diligent effort to place the instant application in condition for allowance and in adherence to principles of compact prosecution and 37 CFR § 1.116 (e), Applicants submit the Declarations Under 37 CFR 1.132 of Ms. Rommy Revson and Ms. Mary Lafauci -- persons of extraordinary if not unparalleled skill in the subject art -- which make it indisputably clear that the invention defined in Applicants' claims prescribes a hair holding device that effectively eliminates the well-known and long-standing problem of slippage associated with spring biased hair clip devices which, prior to Applicants' invention, has not been solved by the prior art.

As Ms. Revson and Ms. Lafauci unequivocally aver, they recognized but repeatedly tried and failed to solve the same long-standing problem addressed and solved by Applicants. *Markman v. Lehman*, 987 F. Supp. 25, 43, 45 USPQ2d 1385, 1399 (d. D.C. 1997), *aff'd*, 178 F.3d 1306 (Fed. Cir. 1998) (unpublished) ("Establishing a long-felt need requires a showing that others skilled in the art in fact perceived a need and that this perception persisted over a long period of time without resolution by the prior art ....")

Applicant Bruce Rogers is the inventor of U.S. Patent No. 6,276,369 for HAIR BAND SYSTEM WITH STORAGE AND DISPLAY DEVICE. Assuming the level of ordinary skill in the instant art

Application No.: 10/763,846

Amendment Dated: December 18, 2007

Reply to FINAL Office Action Dated: October 29, 2007

to be, at the lowest, a typical consumer of hair fashion products, or at the highest, a hairdresser, fashion designer or the like (either of whom does not hold a patent, has filed a patent application or has not published articles related to the presently disclosed and claimed technology), then at least Applicant Bruce A. Rogers should be considered to be a person of "extraordinary skill in the art" against which a legal assessment of what might be considered obvious to a hypothetical person of "ordinary skill in the art" simply does not apply.

However, if Applicant Rogers is presumed to be of "ordinary skill in the art," and the level of "ordinary skill in the art" is to be presumed to that of one who holds a patent or has filed a patent application or has published articles relating to the presently disclosed and claimed technology, then Applicants' invention is still unobvious because others of this elevated "ordinary skill in the art", i.e., multiple patent holders Ms. Revson and Ms. Lafauci -- whose inventions have experienced tremendous commercial success -- have repeatedly tried and failed to satisfy the long-felt need successfully addressed by Applicants prior to Applicants' invention.

Lastly, as a matter of law, the declarations of Ms. Revson and Ms. Lafauci cannot be ignored by the Examiner. "When a patent applicant puts forth rebuttal evidence, the Board [of Appeals] must consider that evidence." 498 F.3d 1345, 1351 (Fed. Cir. 2007) (emphasis added).

Application No.: 10/763,846

Amendment Dated: December 18, 2007

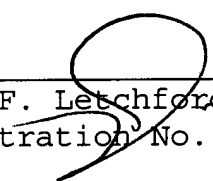
Reply to FINAL Office Action Dated: October 29, 2007

To conclude, the cited prior art does not, in fact, anticipate, suggest or otherwise render obvious the presently claimed invention. And, Applicants' invention satisfies a long-felt need that even those of extraordinary skill in the subject art could not fill prior to Applicants' solution.

In view of the foregoing, the instant application is believed to be in condition for allowance and, therefore, early issuance thereof is earnestly solicited.

Respectfully submitted,

Date: December 18, 2007

  
\_\_\_\_\_  
John F. Letchford  
Registration No. 33,328

ARCHER & GREINER, P.C.  
One Centennial Square  
Haddonfield, NJ 08033  
Tel.: 856-795-2121  
Fax: 856-795-0574  
E-mail: jletchford@archerlaw.com

2967357v1